

REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on March 23, 2006. No fee is due in connection with this Amendment. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112703-306 on the account statement.

Claims 1, 4-11, 14-16, 18-20 and 27-33 are pending in this application. Claims 2-3, 12-13, 17 and 21-26 were previously canceled or withdrawn. In the Office Action, Claims 4, 6, 9-10, 14, 16, 19-20 and 30-31 are rejected under 35 U.S.C. §112, second paragraph and Claims 1, 4-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §103. In response Claims 1, 4, 6, 9-11, 14, 16, 19-20 and 30-31 have been amended. This amendment does not add new matter. In view of the amendment and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 4, 6, 9-10, 14, 16, 19-20 and 30-31 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Patent Office alleges that 4, 6, 9-10, 14, 16, 19-20 and 30-31 do not define the basis for the percent weight calculation. In response, the claims have been amended to address the informalities cited by the Patent Office. The amendments are fully supported in the specification, for example, at page 3, lines 14-19 and page 4, lines 12-23. Based on at least these noted reasons, Applicants believe that Claims 4, 6, 9-10, 14, 16, 19-20 and 30-31 fully comply with 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request that the rejection of Claims 4, 6, 9-10, 14, 16, 19-20 and 30-31 under 35 U.S.C. §112 be withdrawn.

In the Office Action, Claims 1, 4-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,372,824 to Record et al. ("*Record*") in view of U.S. Patent 8,645 to Sturtz ("*Sturtz*"). Claims 1, 4-10, 27-31 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,645,662 to Nakashima et al. ("*Nakashima*") in view of *Sturtz*. Claims 1, 4-5, 7-8, 11, 14-15, 18, 27-29 and 32-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,015,464 to Strobridge et al. ("*Strobridge*") in view of *Sturtz*. Claims 1, 4-11, 14-16, 18-20 and 27-33 are rejected under

35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,149,521 to Hirose et al. (“*Hirose*”) in view of U.S. Plant 8,645 to Sturtz (“*Sturtz*”). Applicants believe these rejections are improper and respectfully traverse them for at least the reasons set forth below.

Applicants have amended independent Claims 1 and 11 to recite, in part, a consumable oral product comprising Erospicata oil, a cooling agent and a heating agent. The amendment is supported in the specification, for example, at page 3, lines 3-13. Independent Claims 32-33 are directed, in part, to a method for making an oral product comprising the step of adding Erospicata oil and a cooling agent to the product. The oral product can be, for example, chewing gum. In contrast, Applicants respectfully submit that the combination of the cited references is improper and/or even if combinable the cited references fail to disclose or suggest every element of the present claims.

Record and *Sturtz* fail to disclose any heating agent as required, in part, by Claims 1 and 11. Applicants respectfully disagree with the Patent Office’s assertion that Example 3A teaches a heating agent. See, Office Action, page 4, lines 18-20. In fact, *Record* fails to explicitly mention a heating agent or use thereof anywhere in its disclosure. *Record* and *Sturtz* also fail to disclose the step of adding Erospicata oil and a cooling agent to a consumable product as required, in part, by Claims 32-33. In fact, *Record* is directed to a mint oils that typically have a significant portion of 1-menthol (see, *Record*, column 3, lines 36-45), which teaches away from the present invention. Because of this undesirable level of this compound, *Record* must use a method of removing at least a portion of 1-menthol present in mint flavor before adding the flavor to a chewing gum. See, *Record*, column 7, lines 21-22. This teaches away from the present invention because Erospicata oil already contains a low 1-menthol concentration. Consequently, the present invention provides an advantage over *Record* because this 1-menthol removal step is avoided.

Nakashima and *Sturtz* fail to disclose any heating agent as required, in part, by Claims 1 and 11. Applicants respectfully disagree with the Patent Office’s assertion that *Nakashima* teaches a heating agent. See, Office Action, page 6, line 22. In fact, *Nakashima* fails to explicitly mention a heating agent or use thereof anywhere in its disclosure. *Nakashima* and *Sturtz* also fail to disclose the step of adding Erospicata oil and a cooling agent to a consumable product as required, in part, by Claims 32-33.

Strobridge is directed to mint oils that typically have a significant portion of 1-menthol (see, *Record*, column 3, lines 19-30), which teaches away from the present invention and *Sturtz*. In fact, *Strobridge* fails to recognize the advantages, benefits and/or properties of using Erospicata oil in a consumable composition. *Strobridge* and *Sturtz* also fail to disclose the step of adding Erospicata oil and a cooling agent to a consumable product as required, in part, by Claims 32-33.

Hirose is directed to mint oils that typically have a significant portion of 1-menthol (see, *Hirose*, column 4, lines 62-68), which teaches away from the present invention and *Sturtz*. In fact, *Hirose* fails to recognize the advantages, benefits and/or properties of using Erospicata oil in a consumable composition. *Hirose* and *Sturtz* also fail to disclose the step of adding Erospicata oil and a cooling agent to a consumable product as required, in part, by Claims 32-33.

Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by selectively piecing together teachings of each of the references in an attempt to recreate what the claimed invention discloses. As the Federal Circuit explained, “the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, at 1783-17. Moreover, one cannot use “hindsight reconstruction to pick and choose among isolated disclosures in the prior art” to re-create the claimed invention. *In re Fine*, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

For at least the reasons discussed above, the combinations of *Record*, *Nakashima*, *Strobridge* or *Hirose* in view of *Sturtz* are improper and/or do not teach, suggest, or even disclose all of the elements of the present claims, and thus, fail to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4-11, 14-16, 18-20 and 27-33 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Robert M. Barrett
Reg. No. 30,142
Customer No.: 29156

Dated: June 23, 2006